

Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

32. The system according to claim 31, the system further comprises the means for receiving a second electronic instruction from the prospective depositor for authorizing the bidder who submitted the winning bid to access the real identity of the prospective depositor for a second selected period of time.

33. The system according to claim 31, wherein said network comprises at least one client computer and the host computer, said host computer further comprising the host authorizer.

REMARKS

1) The above cancellation of Claims 1-14 is believed to resolve the double patenting objection raised by the Examiner. The new claims 15-33 should not conflict with our now abandoned submission for 09/560530, the source of the original conflict.

2) Arguments against §103 rejections are appended as below for your consideration:

Summary

In determining obviousness under section 103, the examiner relied on the Levine US Patent 6233566 as the single prior art ("Levine") reference. This patent is described as an online centralized financial products exchange system wherein the product is a loan or a pool loan. (Levine, Abstract). The examiner did not specifically define the teachings in Levine, which would necessarily lead to identifying the same problem as in the claimed invention. It would be apparent that a skilled artisan, by reading the prior art, would not be able to draw the template for this claimed invention when there is no evidence of suggestion, reason or motivation directing him to issues relating to deposit facilities or the problem identified by this claimed invention. In *Richard Rutz v Chance Co* (No. 99-1557, United States Court of Appeals for the Federal Circuit, decided December 6, 2000) "In order to prevent a hindsight-based obviousness analysis, it has been established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references." Our contention is that the

Application number: 09/534,233

Art Unit: 3628

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Title: System and method for conducting an electronic financial asset deposit auction over computer network

examiner erred in holding claims 1-14 unpatentable under 35 U.S.C. § 103(a) over Levine. Specifically, Levine does not teach or suggest the discovering by solicitation of better deposit terms in an auction environment where such deposits may include shares. More generally, there is no substantial evidence on record to extrapolate Levine's teaching of loan origination, pooling and trading to reach the invention now claimed in independent Claims 15, 25, 29 and 31. In short, a loan is not a deposit and the claimed invention's scope is concerned with a problem not identified by Levine, nor is it obvious in a loan application. We cannot agree that there is such relevant evidence as a reasonable mind might accept as adequate to support implicitly the conclusion that a skilled artisan confronted with (1) the problem, i.e., finding a method to discover better deposit terms, and (2) the teachings in Levine, would have been motivated to modify a system for loan origination, pooling and trading in an exchange environment for said purpose. In particular we submit that Levine did not suggest discovering a better return for potential depositors in an auction, or shares depositing or where a bid includes shares in exchange. Because a deposit application cannot be sold in an exchange as an application is merely an invitation to contract and not a loan application.

The following submission will discuss each of the ingredients that the examiner has failed to establish under a proper *prima facie* as required under a 35 U.S.C. § 103(a) rejection.

I. Obviousness under 35 U.S.C. § 103

1.1 There must be a basis in the art for combining or modifying references

A 35 U.S.C. § 103 rejection presumes the existence of differences between the subject matter claimed and the teachings of the prior art, otherwise a 102 would have sufficed. Thus the examiner must be able to point to something in the prior art that suggests in some way a modification of a particular reference in order to arrive at the claimed invention. (*In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed Cir 1987). As an example of this neglect, we can use the examiner's disclosure for Claim 1 (page 2 to page 5 of Action Letter mailed 18 July 2002), nowhere has the examiner pointed a suggestion to modify a loan application to a deposit application.

Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

**Title: System and method for conducting an electronic financial asset deposit
auction over computer network**

a suggestion to solicit competitive deposit terms or a suggestion why an auction should be used in lieu of an exchange. The examiner had only recited Levine's methods and system as per the prior art. The only suggestion made by the examiner concerned with protecting the identity of the applicants which points to the benefit of avoiding unauthorized use of the system. We submit this suggestion is not proper for the reason that protecting the identity of the applicant using a handle (see Claims 18, 27, 29, 31,) is not for avoiding unauthorized use of the system. A handle is only used to protect the identity of the applicants during an auction and not particularly for accessing the system. A handle for concealing a loan applicant's identity would defeat the process and hence must held to be not obvious. A handle for a deposit application in the real world to conceal the deposit applicant's identity would similarly defeat the process and is contrary to the accepted common practice. Therefore it would not be obvious to have a handle in the online world.

1.2 "Obvious to try" a modification or combination (looking for a needle in a haystack) is not prima facie obvious.

At best, we submit that in light of the reference, one skilled in the art of banking in general might find it obvious to try various combinations of these known elements. However this is not a standard for 35 U.S.C. § 103.

1.3 A reference is not properly modifiable if its intended function is destroyed.

A 35 U.S.C. § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the prima facie case of obviousness cannot be properly made. Drawing this assumption to Levine's system, it is fairly obvious by applying the anonymous application requirement, the system would not be able to process any loan application. Without able to originate a loan, there will be no trading or pooling of loans.

Application number: 09/534,233

Art Units: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

1.4 Non-analogous Art

In *re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), the court held the prior art process reference to be non-analogous to the claimed invention even though both were used in the petroleum industry and both involved handling petroleum products in volumetric enclosures. The claimed invention in *re Clay* was a method for storing refined petroleum products in a man-made storage tank. The references were to a method for extracting crude oil from porous hydrocarbon-bearing natural underground formations. These italicized features, the court said, show a different "field of endeavor" and different "purposes", which defeat the possibility of dealing with or solving a common problem. Similarly, in our submission was a method for soliciting competitive deposit terms while the reference provides a way to originate loans and to trade loan products which defeats the possibility of dealing with or solving a common problem. The definitions of "deposit terms" and "loan or loan products" are obviously in different fields of endeavor. See definition of deposit under The Federal Deposit Insurance Act ("FDIA") which defines "deposit" as follows at section 3(l):

"(1) the unpaid balance of money or its equivalent received or held by a bank or savings association in the usual course of business and for which it has given or is obligated to give credit, either conditionally or unconditionally, to a commercial, checking, savings, time, or thrift account,...." (Note Section 3(l) consists of 5 subsections which are not reproduced in full here.) Also see 12 CFR 204.2 which provides similar definition of a deposit.

In short, had Levine wanted to include a 'loan' for banks then there would be teaching of a deposit, as this is the proper terminology to use by convention. The fact that there is no evidence of this can only mean that a deposit is neither obvious nor intended.

Furthermore, in a recent case, the court has ruled that "flat fee charges to deposit customers for checks written without sufficient funds on deposit do not constitute 'interest' as limited by 12 USC 85. The fee is a processing fee, not compensation for an extension of credit." *VideoTrax, Inc. v. NationsBank, N.A.*, 33 F.Supp.2d 1041 (S.D. Fla. 1998), aff'd 205 F.3d 1358 (11th Cir.2000), cert. den. 1212 S. Ct. 66 (October 2, 2000). It is therefore fairly clear that the court's interpretation means

Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

to maintain the meaning of a "deposit" even when its form has been extended to one of an extension of credit (loan) by default. We therefore conclude the differences between the two both in form and in substance must stand legally and is undeniable.

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As provided under the scope of the prior art, the prior art must include art that is "reasonably pertinent to the particular problem with which the invention was involved." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). In applying this reasoning, the particular problem in Levine is aimed towards the creation of a system to solve the ad hoc manner to interact and to sell loans or pool of loans (Levine Col 4 Ln 34-36 and Ln 46-51). It is also said that that it provides a marketplace for this purpose (Levine Col 6 Ln 2) to trade this product i.e., a loan. Another aim is the reduction in manual re-entry of data associated with the transaction (Levine Col 6 Ln 6-10). Levine's system is also designed to store rules (Levine Col 6 Ln 15-19). In the claimed invention, the particular problem is not the same as recited above nor is it as complex. While the prior art mentions loan application (not deposit application), it does so as a precursor to enable the creation and trading of loans.

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The prior art clearly does not provide such an insight to the problem of discovering better returns, because it is not within its scope. One reason for this is because the loan application is either accepted or rejected and the interest charged is linked to the risk profile of the borrower, and is hence settled during the time of negotiation. In the claimed invention, the potential depositor has the opportunity to decide and select the best bid rather than having the financial institution making the final decision as common in the art.

1.5 Prior Art does not teach the problem or its source.

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The solution to a problem, once known, is often obvious even when the recognition of the problem itself or of the source of the problem is not. The historical case of *Eibel Process Co V Minnesota and Ontario Paper Co.*, 261 US 45(1923), established the rule that the discovery of the source of a problem may result in a

Application number: 09/534,233**Art Unit: 3628****Applicant: Khai Hee Kwan****Examiners: Clement, B Graham.****Title: System and method for conducting an electronic financial asset deposit auction over computer network**

patentable invention despite the fact that the solution would have been obvious once the source of the problem was discovered.

In re Peehs, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980) the court held that to establish a *prima facie* case of obviousness where the advance in the art lies in the discovery of the problem or the source of the problem, the examiner would have to provide evidence that a person of ordinary skill in the art at the time of the invention would have expected a problem to exist. In that case, neither the problem nor the source of the problem were known in the art.

It is obvious the examiner did not point out any 'problem' in the prior art that would have existed or been linked to solicitation of a better borrowing rate for the borrower. It is also quite clear in the art that any borrowing rate for a borrower is decided upon the individual's credit rating and risk profile, which in most cases are matters of fact that are not negotiable. As the prior art pointed out, strict adherence to these 'rules' is important so that loans, once created, can be pooled and sold. Table A below shows some differences between the cited prior art and the claimed invention in the tabulated problem and solution.

Table A

Source	Problem	Solution
Levine (Col 4 Ln 33-50)	Ad-hoc buying and selling of loans, no mechanism to determine what loans or pool are for sell, what rules are being applied to pool loans.	A centralized market for trading of loans and storing rules for loan origination.
Claimed Invention	Currently a user has to look for deposit rates or browse portals with rates to search for the best return. This is time	Use an anonymous online bidding system. Returns in the form of a bid from financial institutions can be in cash or non-cash

Application number: 09/534,233**Art Unit: 3628****Applicant: Khai Hec Kwan****Examiner: Clement, B Graham****Title: System and method for conducting an electronic financial asset deposit auction over computer network**

	consuming and the rates are inflexible with fixed terms imposed by banks. The user wants a quick and easy way to find the best return on deposit assets without revealing oneself to the financial institution. He or she also wants to have flexibility, i.e., to be able to dictate terms, including non-financial deposits.	(shares) format depending on how the bid is structured. Bid can also include incentives such as different payment schedules etc. The system designed here must be flexible to accommodate all kind of bids as claimed hence no rules as compared to Prior Art which prefers rules.
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1.6 Application of the Graham Factors

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The necessity of a complete Graham findings is especially important where the invention is less technologically complex, as is the case here. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds. In *re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). In such a case, the danger increases that "the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

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A preferred embodiment of the claimed invention is basically a simple programmed computer with only one utility -- to provide potential deposit applicants the means to discover competitive returns by way of an auction system deployed on a network. Deposit, in this sense, includes both shares and cash. To fulfill this task, anonymous applications are displayed online and bidders, such as financial institutions, respond by bidding for the applications by providing their own deposit terms on a competitive basis. If the bid is selected (at the end of the auction), the bidder gets to

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Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

contact the applicant to complete the depositing requirements as agreed in the terms of the bid. While this is a system designed for the online world, we submit that such a process does not even exist in the real world and therefore this is a pioneering process despite its simplicity.

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

In order to prevent a hindsight-based obviousness analysis, it has been established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references as discussed previously. See, e.g., In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617 ("Case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). "Determining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness." Sibia Neurosciences, Inc. v. Cadus Pharma Corp., 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); Tec Air, Inc. v. Denso Mfg., Inc., 192 F.3d 1353, 1359, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with those of another reference).

The examiner has recited separate common elements from the prior art and concluded that it would have been obvious to combine loan application and trading of such loans to arrive at the claimed invention. The examiner made no mention of a deposit application auction, as recited in the independent claims, (although this is a

Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

key difference as noted above) in his determination, nor did he comment on the inherent difference between a loan sale and discovering a better return on a deposit. Moreover, he did not comment on why an auction is obvious over an exchange as in the prior art or why would a deposit application be obvious in view of a loan application ?

We cannot agree with the examiner's rejection on the grounds that the common elements cited in canceled independent claims 1, 13 and new claims 15, 25, 29, 31 are old. These elements, such as a computer, a network, a database, and bids, are indeed found in the prior art, but there is "a general rule that combination claims can consist of combinations of old elements as well as new elements," *Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1189-90 (Fed. Cir. 2000), "[t]he notion . . . that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575, 1 USPQ2d 1593, 1603 (Fed. Cir. 1987); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.").

Taking Claim 1 as a representation of the claimed invention, the examiner concluded that "Levine et al does not explicitly teach means for protecting the real identities of all participants including the use of a password login procedure. It would have been obvious to one of ordinary skill in the art at the time the invention was made that pre-registered buyers and sellers would have used some form of identity to access the system that was given to them during the registration process. The benefit would have been to avoid unauthorized use of the system." Page 5, Action Letter dated 18 July 2002.

The complete wording of this claim 1(n) is "means for protecting the real identities of all participants including the use of a password/login procedure and the use of handle for said record of such lending/deposit auction application in said database after they have been approved to participate in the auction" (See Claim 18,27,29, 31

Application number: 09/534,233**Art Unit: 3628****Applicant: Khai Hee Kwan****Examiner: Clement, B Graham.****Title: System and method for conducting an electronic financial asset deposit auction over computer network**

for a comparable recital). It is submitted that the motivation on record is not appropriate because it did not sustain reasons for using a handle which was omitted from the examiner's worded explanation. While it is true that a login and password are required to access any system in order to prevent unauthorized access, there is
5 no link to protecting the identities of the applicants in the deposit application when inserted in the database for access by others, which is the essence of this element. Why is it essential to have a handle if the stated motivation is to access the system? Would having a handle be obvious if the motivation is merely to access a system? It is also clear that anonymity is contrary to one skilled in the art of loan systems,
10 because a loan system should be able to identify the borrower clearly and distinctly in order to process the loan application. The only conclusion is that inappropriate hindsight has been used.

If we draw a parallel to a loan application, anonymity would render it defective to
15 the extent that no origination as a pre-cursor to loan pooling and trading will be possible. Levine provided extensive evidence of this in his figures such as in FIG 8,9,11,12,13,18 etc where the borrower's details are known.

A market system for any use is well known in the art, therefore elements of
20 receiving bids, and posting offers are old as well as found in the prior art. The test here is not whether one device can be an appropriate substitute for another as seems to be suggested by the examiner even though there are inherent difference between an auction and exchange. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986) ("Focusing on the obviousness
25 of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness."); *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) ("A patentable invention, within
30 the ambit of 35 U.S.C. §103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.") (emphasis omitted).

Application number: 09/534,233**Art Unit: 3628****Applicant: Khai Hee Kwan****Examiner: Clement, B Graham.****Title: System and method for conducting an electronic financial asset deposit auction over computer network**

There is also no evidence provided by the examiner that Levine can solve the same problem as to motivate the skilled artisan as required in the claimed invention. In fact it is quite clear from the prior art's disclosure that the interest rate assigned to the loan applicant is one determined from the risk profile of the borrower, as well known in the art. In view of this it will be inconsistent for other loan agents to assign a better rate (lower) or compete for a loan application because one cannot exclude this rating protocol. Nor will it be useful to have a loan embodying a certain type of risk to be given a lower rate in order to secure the business and later found to be problematic in the pooling and trading stage. Levine expressed the need for loan originators to pay particular attention to the rules of the buyers before accepting loans. (Col 9 , Ln 50-53) All these considerations have no bearing at all with a deposit application for the simple reason that there is no credit profile of a depositor. This is, however, not the same as verifying the existence of assets proposed to be deposited with the depositor as a manner of qualification.

Specifically, there were no findings on whether there was a disadvantage in the prior system, such that the "nature of the problem" (despite being not similar) would have motivated a person of ordinary skill to modify the prior art to reach the claimed invention. Indeed, that these elements (or even a mere telephone) as noted by the examiner have been in the public domain available for years to all skilled workers, without, as we found, suggesting anything like the claimed invention, is itself evidence of nonobviousness. Panduit, 810 F.2d at 1577, 1 USPQ2d at 1605.

We therefore conclude that Graham was not in fact applied consistently.

1.7 Preamble Statements are limitation

Statements in the claims that define and limit the device are material limitations, for purposes of infringement and for purposes of distinguishing from the prior art. See, e.g., Rowe v. Dror, 112 F.3d 473, 478-79, 42 USPQ2d 1550, 1553-54 (Fed. Cir. 1997) (the field of the invention as stated in a Jepson-type claim limits the invention); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-78, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (limitations stated in the preamble limit the

Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

claimed invention), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) (function stated in claim distinguishes from prior art). In this application "electronic financial asset deposit auction" is not a common element nor known.

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In *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040 (1997) the Court stressed the importance of claim limitations. If read with the preamble, applicant's device is not known, but is new, and the claims are explicitly so limited it as an electronic deposit application auction system. See *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255-57, 9 USPQ2d 1962, 1965-66 (Fed. Cir. 1989) ("To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality."); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 or 842 F.2d 1275 (anticipation can not be based on conjecture).

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The claimed system has a novel structure and function, and is capable of receiving deposit applications while providing anonymity for the applicants. Adhering strictly to the difference between a loan and deposit, there is no evidence to suggest that the methods in the prior art are capable of receiving a deposit application without further undue experimentation. Such experimentation means the anonymous application must be sent to all bidders (the prior art teaches that the loan originator must process the loan application) instead of sending it to the host computer for processing and eventually being displayed over a network.

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The claimed invention allows bidders to bid for these applications for a selected time period. The claims stressed "application" which is not a product such as a deposit or loan. A deposit, and hence a depositing relationship, exists once the application is agreed to by both parties and not when it is the subject of bids by parties whose individual identities are unknown. The prior art deals with a tradable product, such as a loan, in an exchange environment while an application is merely an invitation to contract. The claimed invention functions to provide responsive bid information including competitively proposed terms of deposit to the potential deposit applicants. The prior art facilitates the buying and selling of loans or pooled loans where such transactions result in rights being transferred by legal instruments.

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Application number: 09/534,233

Art Unit: 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

In the present claims, the element "deposit application" has a distinct relationship to the preamble "solicitation" and therefore gives life and meaning to the claim because without the application there cannot be any solicitation electronic or otherwise. *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951). In that case the court held that the preamble phrase "An abrasive article" did constitute a claim limitation because the "term calls forth a distinct relationship between the proportion of grain and resin [both elements being in the body of the claim]" and therefore gave "life and meaning" to the claim. *Id.* at 152, 88 USPQ at 481.

1.8 Level of Ordinary Skill in the Art

The determination of the level of ordinary skill in the art is an integral part of the Graham analysis. See *Custom Accessories*, 807 F.2d at 962, 1 USPQ2d at 1201 ("Without [a determination of the level of ordinary skill in the art], a district court cannot properly assess obviousness because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art.") (internal citation omitted). Factors that may be considered in determining the ordinary level of skill in the art include: 1) the types of problems encountered in the art; 2) the prior art solutions to those problems; 3) the rapidity with which innovations are made; 4) the sophistication of the technology; and 5) the educational level of active workers in the field. See *id.* at 962, 1 USPQ2d at 1201 (citing *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697, 218 USPQ 865, 868-69 (Fed. Cir. 1983)).

We consider the examiner's failure to make on record, a proper finding on the level of ordinary skilled detrimental and other Graham findings evidence that Graham was not, in fact, applied consistently.

Conclusion. While we have presented our rebuttal for prima facie, we also submit that all previous claims 1-14 have been cancelled to avoid double patenting issue

Application number: 09/534,233

Art Units 3628

Applicant: Khai Hee Kwan

Examiner: Clement, B Graham.

Title: System and method for conducting an electronic financial asset deposit auction over computer network

raised previously. The new claims 15-33 should not conflict with our now abandoned application 09/560530, the source of the original conflict.

Please note that although we have cancelled the original claims, they were done so to avoid double patenting. ALL of the elements have been retained in different forms in Claims 15-33.

The amendments and the arguments presented supra are believed to traverse the Examiner's rejection under 35 U.S.C. §103. Reconsideration of the rejection is requested.

3) I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any application, any patent issuing thereon, or any patent to which this verified statement is directed.

Official

Date: 15 Oct 2002

Khai Hee KWAN

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Page 20 of 20

Attachment A**MARKUP VERSION****1****Application number: 09/534233**

For example, there are individuals who prefer higher risk than available from standard banking depositing facilities by accepting securities in exchange under certain terms. There are borrowers such as banks who from time to time may willing to pay to secure some critical funding requirements

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